

REMARKS

This responds to the Office Action mailed on March 10, 2006. Claims 1, 7, 12, 16 and 22 are amended. Claims 1-23 are now pending in this application. Applicant does not admit that the cited references are prior art and reserves the right to swear behind the references at a later date.

§102 Rejection of the Claims

Claim 1-7, 11 and 12

Claims 1-7, 11 and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ozawa (U.S. Patent 5,757,364). Applicant respectfully traverses the rejection. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.¹

Among the differences, claim 1, as amended, recites

a logic, separate from the rendering engine, to blend at least one background color with the foreground of the image, after the foreground of the image is rendered by the rendering engine. (emphasis added).

With regard to claim 7, among the differences, as amended, claim 7 recites

the background merge logic to blend, after the rendering engine has rendered the foreground image, the at least one background color received from the video source with a window of the rendered foreground image to generate the merged image. (emphasis added).

Such amendments are at least supported by the flow diagram illustrated in Figure 3. Applicant respectfully submits that Ozawa does not disclose a blend between the background color and the foreground of the image. Further, Applicant submits that Ozawa does not disclose a blend that occurs after the foreground of the image is rendered.

¹ *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

Accordingly, because the cited references do not disclose all of the claim limitations, Applicants respectfully submit that the rejections of claims 1 and 7 under 35 U.S.C. §102 have been overcome. Claims 2-6 and 11, respectively, depend from claims 1 and 7 and distinguish the reference for at least the same reason.

Claim 16 and 18-21

Claims 16 and 18-21 were rejected under 35 U.S.C. § 102(e) as being anticipated by Dawson (U.S. Patent 6,771,274).

With regard to claim 16, among the differences, claim 16, as amended, recites

performing the following operations in a hardware logic that is separate from a rendering engine that renders at least one foreground pixel for a window in the image, wherein the following operations are performed after the at least one foreground pixel is rendered. (emphasis added).

With regard to claim 19, among the differences, claim 19, recites

blending, by a hardware logic that is separate from the rendering engine, the image based on a merger of a background fill pixels with the foreground pixels.

In the Response to Argument section, the Office indicated the following:

It is noted that a separate rendering engine is inherent to the “previously rendered polygon” of Dawson. If the invention in figure 5 is receiving a rendered polygon, and does not render the polygon itself, the polygon must have been rendered separately from the invention in figure 5. Furthermore, this polygon must have been rendered by some sort of electrical or computer device capable of rendering, any of which would read on a rendering engine.² (emphasis added).

The Office admitted that Dawson does not teach the separate rendering engine. But, the

² Office Action at ¶3.

Office maintained that this separate rendering engine is inherent therein. Applicant respectfully disagrees because the Office has not established a *prima facie* case of inherency. As recited in MPEP § 2112, “In relying upon the theory of inherency, the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Office is assuming that in Dawson, a separate component rendered the polygon. Specifically, the Office indicated that the polygon “must have been rendered separately from the invention in figure 5.”³ Dawson does not require that a separate component render the polygon. Moreover, there is no basis in fact or technical reasoning to require that a separate component perform this operation. For example, element 230 of Figure 2 that performed the blending of the background pixel with the foreground pixel (as noted in the Office Action at ¶14) could render the foreground pixel. Thus, the Office Action does not even assert that the allegedly inherent characteristic is necessary, let alone provide a basis in fact and/or technical reasoning.

To serve as an anticipation when a reference is silent about the asserted inherent characteristic, the gap in the reference may be filled with recourse to extrinsic evidence. But, such evidence must make clear that “the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”⁴ Applicant respectfully submits that the Examiner has not produced extrinsic evidence to show that the separate rendering engine recited in claims 16 and 19 is necessarily present in Dawson.

Moreover, claim 19 also recites “rendering an image in a front-to-back order.” The Office indicated that this limitation is disclosed by Figures 1 and 5. Applicant respectfully traverses this assertion. Neither Figure 1 nor Figure 5 discloses an order of rendering. Specifically, neither Figure discloses a rendering in a front to back order. Figure 1 relates to an alpha blending operation. The description of Figure 1 does not disclose an order of the rendering of the foreground pixels and the background pixels. In the description of Figure 1, the foreground (the polygon 12) and the background (video background 14) have already been

³ Office Action at ¶3.

⁴ *Continental Can Co. v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

rendered. Figure 5 relates to alpha blending and V blending. Similar to Figure 1, Figure 5 does not disclose an order of the rendering of the foreground pixels and the background pixels.

Accordingly, because the cited references do not disclose all of the claim limitations, Applicants respectfully submit that the rejection of claims 16 and 19 under 35 U.S.C. §102 has been overcome. Claims 18 and 20-21 respectively depend from claims 16 and 19 and distinguish the reference for at least the same reason.

§103 Rejection of the Claims

Claims 8-10, 13-15 and 22-23 were rejected under 35 USC § 103(a) as being unpatentable over Ozawa in view of Dawson. Claim 17 was rejected under 35 USC § 103(a) as being unpatentable over Dawson in view of Ozawa.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness.⁵ To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references.⁶

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so."⁷

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to

⁵ *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

⁶ *Id.*

⁷ *Id.* (emphasis in original).

make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.⁸

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference.⁹ At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching.¹⁰

Claims 8-10

Because claims 8-10 depend from and further define claim 7, Applicants respectfully submit that the rejection of claims 8-10 under 35 U.S.C. §103 has been overcome.

Claims 13-15

Because claims 13-15 depend from and further define claim 12, Applicants respectfully submit that the rejection of claims 13-15 under 35 U.S.C. §103 has been overcome.

Claims 22-23

Among the differences, claim 22, as amended, recites

performing the following operations, after rendering of the color data by the rendering engine, in a graphics logic having a background color table, independent of operations by the rendering engine. (emphasis added).

Such amendments are at least supported by the flow diagram illustrated in Figure 3.

⁸ M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

⁹ *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992).

¹⁰ (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

In the Response to Arguments section, the Office seems to indicate that claim 22 recites “merging” rather than “blending.”¹¹ However, claim 22 recites “blending the adjusted color data of the background pixel with the color data of the foreground pixel.” As set forth above, Ozawa does not disclose a blend between the background color and the foreground of the image. Further, Applicant submits that neither Ozawa nor Dawson disclose a blend that occurs after the foreground of the image is rendered.

Therefore, neither Ozawa nor Dawson alone or in combination, disclose or suggest all of the claim limitations. Accordingly, Applicants respectfully submit that the rejection of claim 22 under 35 U.S.C. §103 has been overcome. Claim 23 depends from claim 22 and distinguishes the reference for at least the same reason.

¹¹ See discussion of the definition of “merge” in the Office Action at ¶2.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 371-2103 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

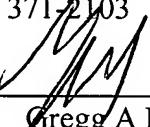
Respectfully submitted,

WILLIAM R. HANCOCK

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 371-2103

By


Gregg A Peacock
Reg. No. 45,001

Date 5-10-06

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 10th day of May, 2006.

Name

Dawn M. Peacock

Signature

Dawn M. Peacock